REMARKS

Reconsideration and withdrawal of the restriction requirement and election of species are respectfully requested in view of the remarks herein.

The Office Action required restriction from among:

Group I: Claims 1-20 and 22, drawn to a process for preparing a polymerizable composition, classified in class 526, subclass 318; and,

Group II: Claim 21, drawn to an ocular device, classified in class 623, subclass 4.1+.

Applicants hereby elect, with traverse, the claims of Group I.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions." *Id.*

The Office Action states that the Groups of claims are distinct as they are related as product and process of making and the process as claims "can be used to make other and materially different product, such as a device that is not used for ocular device application." Office Action at 4. Applicants respectfully submit that such a statement is not sufficient to support a determination of distinction. According to MPEP 806.05(f), the Examiner is required to indicate what materially different product can be made, although documentation of that product is not required. It is respectfully submitted that "a device that is not used for ocular device application" is not an acceptable description of an alternative product. Such a statement is akin to merely stating "a device other than the device claimed" and falls short of the Office's duty to provide a specific example of an alternate device in making such a restriction requirement. For this reason alone, restriction is improper and should be withdrawn.

Furthermore, for a restriction requirement to be proper, it must satisfy **both** of the above elements. Accordingly, the present restriction requirement is improper and must be withdrawn because the Office Action only alleges that the inventions are distinct, as described above. The Office Action provides no showing that search and examination of claims 1-22 would be an

undue and serious burden. Indeed, the search and examination of all of the claims of Groups I and II would add only a single claim to those which are to be searched and examined as a result of the election of Group I. Only claim 21 would be added to the claims of Group I (claims 1-20 and 22), and there has been no showing that the search and examination of **one additional claim** would result in an undue burden on the Examiner. Therefore, the restriction requirement is improper because it does not satisfy both requirements for restriction and should be withdrawn.

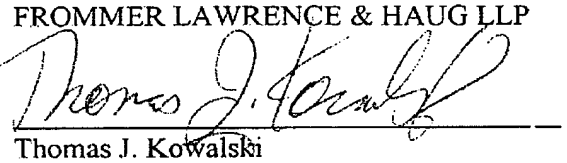
In view of the remarks herein, enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, whereby a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially in view of the lack of assertions in the Office Action as to the requisite showing of serious burden, in contrast to the requirements of MPEP 803.04. Indeed, the search and examination of each Group would likely be co-extensive and, in any event, would involve such interrelated art that search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction and election species.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

CONCLUSION

Reconsideration and withdrawal of the restriction requirement and an early and favorable examination on the merits is respectfully requested in view of the remarks herein.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 

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